UNITED STATES PATENT AND TRADEMARK OFFICE

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09/895,525	06/28/2001	Manoel Tenorio	020431.0843	8191

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>21 February 2008</u>.

2a) ☐ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-37</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-37</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

Response to Amendment

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Feb. 21, 2008 has been entered.

Claims 1-37 are pending for examination, claims 1 and 35 have been amended.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

As to claims 23-33 and 37, the instant specification fails to explicitly define the claimed "computer-readable" medium, thus, the claimed subject matter is lacking of antecedent basis.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or
composition of matter, or any new and useful improvement thereof, may obtain a patent
therefor, subject to the conditions and requirements of this title.

As set forth in MPEP 21 06(II)A:

Identify and understand Any Practical Application Asserted for the Invention The
claimed invention as a whole must accomplish a practical application. That is, it must
produce a "useful, concrete and tangible." State Street, 149 F.3d at 1373,
47USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to
inventions that possess a certain level of "real world" value, as opposed to subject matter
that represents nothing more than an idea or concept, or is simply a starting point for
future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ
689, 693-96),' In re Ziegler, 992, F.2d 1 197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed.
Cir. 199334. Accordingly, a complete disclosure should contain some indication of the
practical application for the claimed invention, i.e., why the applicant believes the claimed
invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent
eligibility standard requires significant functionality to be present to satisfy the useful
result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057,
22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a
computer-readable medium does not make the invention eligible for patenting.   For
example, a claim directed to a word processing file stored on a disk may satisfy the utility
requirement of 35 U.S.C. 101 since the information stored may have some "real world"
value. However, the mere fact that the claim may satisfy the utility requirement of 35
U.S.C. 101 does not mean that a useful result is achieved under the practical application
requirement. The claimed invention as a whole must produce a "useful, concrete and
tangible" result to have a practical application.

The claimed invention is subject to the test of State Street, 149 F.3d at 1373-74,
47 USPQ2d at 1601-02. Specifically State Street sets forth that the claimed invention
must produce a "useful, concrete and tangible result". The Interim Guidelines for
Examination of Patent Applications for Patent Subject Maher Eligibility states in section
IV C. 2 b. (2) (on page 21 in the PDF format):

The tangible requirement does not necessarily mean that a claim must either be
tied to a particular machine or apparatus or must operate to change articles or materials
to a different state or thing. However, the tangible requirement does require that the claim
must recite more than a §101 judicial exception, in that the process claim must set forth a
practical application of that §101 judicial exception to produce a real-world result.
Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no
substantial practical application").

Claims 1-11, 23-33, 34-35 and 37, are rejected under 35 U.S.C. § 101

because the claimed invention is directed to non-statutory subject matter.

As to claims 1-11 and 34-35, these system claims merely recited a data

association module having intended functional processing for manipulate one or

more seller databases in the claimed preamble, the claimed body lacks of any

physical hardware devices to actually perform the claimed intended utility to

constitute a real world application, as such, the whole system seems to be

software per se, which renders the claimed system as non-statutory.

As to claims 23-33 and 37, applicant fails to defined the claimed

"computer-readable" medium, such a medium may take many forms, including,

but not limited to, non-volatile, volatile and transmission media etc... If the

computer readable medium takes the form of the transmission signal, this would

render the claim not statutory because it's not tangle. Since the claim lack the

necessary definition of the claimed medium to constitute a machine or a

manufacture within the meaning of 35 USC 101. They are clearly not a series of

steps or acts to be a process nor are they a combination of chemical compounds

to be a composition of matter. As such, they fail to fall within a statutory category.

They are, at best, functional descriptive material per se.

To expedite a complete examination of the instant application the claims

rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set

forth below in anticipation of applicant amending these claims to place them

within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-18, 20-29 and 31-37, are rejected under 35 U.S.C. 102(b) as being anticipated by Call (U.S. Patent No. 6,154,738).

As to claims 1, 12, 23, and 34-37, Call discloses a computer-implemented system with method and executable program products for categorizing product data in an electronic commerce transaction [e.g., Abstract, Fig(s). 1-8 and associated texts] as claimed by applicant, comprising the following functions:

a data association module [e.g., the "Web register" module at Abstract, lines 14-20, Fig(s). 1- 8 and associated texts] coupled with one or more seller database [e.g., the reseller units: 105, 107 at col. 14, lines 43-55] and a global content directory server [e.g., the Internet light weight directory server at Abstract, lines 6-7, the product manufacturer servers at col. 12, lines 21-38], the data association module operable to:

a) access a first product classification schema, the first schema comprising a taxonomy that comprising a hierarchy of classes for categorizing one or more products [e.g., col. 11, lines 61- col. 12, lines 46], the first schema further comprising ontology associated with one or more of the classes [e.g., the use of XML metadata & Document Type Descriptor techniques at col. 25, lines 26 – 34, 53-60], each ontology comprising one or more product attributes, wherein each of the one or more products is associated with a global unique identifier [e.g., the use of universal product code cross-referencing schema with

domain name services over an Internet at col. 21, lines 6 – col. 22, lines 53, Fig 6
and associated texts];

b) access target data to be associated with the first schema, the target
data organized according the a second product classification schema [e.g., col.
22, lines 55—col. 26, lines 27, Fig. 6 and associated texts];

c) determine one or more classes of the first schema with which at least a
portion of the target data is associated based on a comparison between the
target data and the product attributes of the ontologies of the first schema or
between the target data and values for one or more of the product attributes of
the ontologies of the first schema [e.g., the use of cross-reference server at
Fig(s). 3-4 and associated texts];

d) associate the at least a portion of the target data with one or more
classes of the first schema in response to determine, based on the automatic
comparison, the one or more classes of the first schema with which the at least a
portion of the target data should be associated. [e. g., the use of WWW
consortium search engines with XML, Xsl, Xpointer, XLink indexing schema at
col. 25, lines 35 – col. 26, lines 27, col. 33, lines 1-12]; and

e) store the values for the one or more of the product attributes of the
ontologies of the first schema with which the target data is compared in one or
more seller databases [e.g., Fig. 7 and associated texts].

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As to claims 2-6, 13-17 and 24-28, except the limitations recited in claims
1, 12, and 23, Call further discloses that the determining one or more classes of

the first schema with which the at least a portion of the target data is associated comprises identifying a portion of the target data via matching the name, the value, a range of value, the symbol and formatting of a product attribute in the ontology of these one or more classes of the first schema [e.g., Call: Fig. 2 and associated texts, col. 11, lines 65 – col. 12, lines 57].

As to claims 7, 18 and 29, Call further discloses that determining one or more classes of the first schema with which the at least a portion of the target data is associated comprises using vector space analysis to identify multiple portions of the target data including values that correspond to values for multiple product attributes included in the ontologies of these one or more classes of the first schema [e.g., the use of LDAP in the product code cross-referencing schema in a vector domain name space col. 20, lines 30 - col. 21, lines 4].

As to claims 9-11, 20-22 and 31-33, Call further discloses using indicators to determine the association between the system classes and it's attributes and the indicators are pointers [e.g., the use of Xlinks, Xpointers of XML document at col. 24, lines 45-col. 25, line 13].

Claim Rejections - 35 USC § 103 (Continue)

Claims 8, 19 and 30, are rejected under 35 U.S.C. 103(a) as being unpatentable over Call et al. (U.S. Patent No. 6,154,738) in view of Sahai et al. (U.S. Patent No. 7,272,626).

As to claims 8, 19 and 30, Call did not specifically disclose determining one or more classes of the first schema with which the at least a portion of the target data is associated comprising using statistical correlation techniques to identify portions of the target data including values that correspond to values for a product attribute included in the ontologies of these one or more classes of the first schema.

However, Sahai et al. (hereinafter referred as Sahai) discloses using statistical correlation techniques to identify portions of the target data including values as claimed [e.g., Title, Abstract, col. 3, lines 21- col. 4, lines 34, Fig(s) 4-9 and associated texts].

Call and Sahai are of the same field of endeavor to dynamically identify target data with a product classification schema via the use of a global unique identifier in the XML document, hence, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the statistical technique disclosed by Sahai into the system of Call, because by doing so, the combined system will be upgraded to use the well-known statistical correlation techniques to identify portions of the target data including values that correspond to values for a product attribute included in the ontologies of these one or more classes of the first schema, such that the combined system will provide a more precise response to the user in a decentralized manner.

Response to Arguments

Applicant's arguments filed on Feb 21, 2008 have been fully considered but they are not persuasive.

The examiner disagrees with applicant's arguments that "nowhere does Call disclose a data association module."

In reply to the above arguments, the examiner points out that the claimed data association module is met by the "Web register" module at Abstract, lines 14-20], the web register module is clearly implemented by Internet computer communication protocols as shown in Fig. 1 and associated texts of Call.

Call further clearly disclosed his computer implemented internet system is a cross-referencing on-line shopping and searching system that provides product packaging cross-reference service by using a dynamic web registering process which coupled with the Internet Domain Name Service (DNS) having Common Gateway Interfacing browsing functions and various client/server databases protocols including the newly amended hierarchical global content directory server [e.g., the Internet light weight directory server at Abstract, lines 6-7, the product manufacturer servers at col. 12, lines 21-38] and a plurality of seller databases [e.g., the units: 105, 107, Fig. 1, the unit, 500, Fig. 7] integrated together via software programs such as XML, XSL/CSS, XLink, XPointers and RDF schema as shown Fig(s). 1- 8 and associated texts for facilitating the on-line electronic buy/selling ontology processing such as cataloging, accessing, associating, indexing and storing of data as claimed by applicant.

In addition, as addressed above, Sahai et al. (hereinafter referred as Sahai) also discloses using statistical correlation techniques over a Internet electronic service/transaction which were implemented in XML schema tag language to register, associate and identify portions of the target data including values being managed [e.g., Title, Abstract, col. 3, lines 21- col. 4, lines 34, Fig(s) 4-9 and associated texts].

Thus based on the discussion above, because applicant does not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, applicant does not show how the amendments avoid such references or objections. The examiner concludes that the prior art read on the claimed features.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Mauldin (U.S. Patent No. 5,748,954) which disclosed a method of construction a queue and ranked catalog of files stored on a network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN Y. CHEN whose telephone number is (571)272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mofiz Apu can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susan Y Chen/
Partial Sig. Examiner
Art Unit 2161

May 19, 2008